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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,827	04/18/2002	Carsten Griessmann	MERCK 2320	1698
23599	7590	04/06/2004	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/018,827

Applicant(s)

GRIESSMANN ET AL.

Examiner

Tae H Yoon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11, 13-15, 17-20, 22, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/38253 in view of Vanderhoff et al (US 5,830,927) and EP 0 528 602.

WO teaches a dust-free pigment preparation comprising at least 40 wt.% of nacreous pigments in abstract and examples. Various nacreous pigments such as  $\text{TiO}_2$  and/or  $\text{Fe}_2\text{O}_3$  coated substrate such as talc, kaolin or glass are taught at page 3.

The instant invention further recites a styrene-modified polyacrylate having an acid number  $>90$  mg KOH/g over WO. However, the use of said styrene-modified polyacrylate in stabilizing pigments is well known as taught by EP (page 2, lines 19-24) and Vanderhoff et al (table B and col. 12, lines 38-52).

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known pigments stabilizing styrene-modified polyacrylate of Vanderhoff et al in WO since WO teach pigments stabilization and since the use of said styrene-modified polyacrylate in stabilizing pigments is well known as taught by EP and Vanderhoff et al.

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Claims 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/38253 in view of Vanderhoff et al (US 5,830,927) and EP 0 528 602, and further in view of Mead et al (US 5,596,027) and Bellas (US 5,897,698).

The instant invention further recites mica substrate and  $\alpha$ -methylstyrene-modified polyacrylate over WO, Vanderhoff et al and EP.

However, effect pigments comprising  $\text{TiO}_2$  and/or  $\text{Fe}_2\text{O}_3$  coated mica are well known as taught by Bellas (col. 4, lines 10-18). Mead et al teach and equate  $\alpha$ -methylstyrene-modified polyacrylate and styrene-modified polyacrylate at col. 11, lines 9-26.

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known effect pigments based on mica of Bellas and/or  $\alpha$ -methylstyrene-modified polyacrylate of Mead et al in WO, Vanderhoff et al and EP thereof since the instant effect pigments and the use of both  $\alpha$ -methylstyrene-modified polyacrylate and styrene-modified polyacrylate in pigment compositions are well known in the art.

Claims 10-13 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderhoff et al (US 5,830,927) in view of Bellas (US 5,897,698).

Vanderhoff et al teach compositions containing more than 40 wt.% of pigments and styrene-modified polyacrylates having an acid number  $>90$  mg KOH/g in tables A and B and at col. 12, lines 38-52.

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The instant invention further recites effect pigments over Vanderhoff et al, but such effect pigments are well known in the art as taught by Bellas.

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known effect pigments of Bellas in Vanderhoff et al since the use of such effect pigments would be an obvious design choice to one skilled in the art.

Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vanderhoff et al (US 5,830,927) in view of Bellas (US 5,897,698), and further in view of Mead et al (US 5,596,027).

The instant invention further recites  $\alpha$ -methylstyrene-modified polyacrylate over Vanderhoff et al.

However, Mead et al teach and equate  $\alpha$ -methylstyrene-modified polyacrylate and styrene-modified polyacrylate at col. 11, lines 9-26.

It would have been obvious to one skilled in the art at the time of invention to utilize the art well known  $\alpha$ -methylstyrene-modified polyacrylate of Mead et al in Vanderhoff et al and Bellas thereof since Vanderhoff et al teach styrene-modified polyacrylate and since the use of both  $\alpha$ -methylstyrene-modified polyacrylate and styrene-modified polyacrylate in pigmented compositions is a routine practice in the art.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tae H Yoon  
Primary Examiner  
Art Unit 1714

THY/March 25, 2004

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